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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/591,259

08/31/2006

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EXAMINER

SINGH, PREM C

ART UNIT

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1797

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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/591,259	Applicant(s) ADAMS ET AL.	
	Examiner PREM C. SINGH	Art Unit 1797	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 December 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 August 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>12/17/2008</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Amendment

1. Amendment to claims 1, 6 and 8 is noted.
2. Objection to claim 6 is withdrawn.
3. New ground of rejection necessitated by amendment to claim 1 follows.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of

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the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gilbert et al (WO 02/070627 A2) in view of Chen et al (US Patent 4,851,109).

6. With respect to claim 1, Gilbert discloses a process for making multiple grades of base oil products (See page 2, lines 3-7). The process comprises following steps:

(a) hydrocracking a Fischer-Tropsch (FT) derived feed, and obtaining an effluent (See page 2, lines 11-17);

(b) distilling of the effluent as obtained in step (a) into at least one middle distillates product and a full range residue boiling between 330 and 400°C (See page 21, lines 25-27);

(c) catalytically dewaxing the full range residue boiling between 330 and 400°C with a dewaxing catalyst comprising a dealuminated extrudate of a zeolite and a low acidity refractory binder material and Group VIII metal of either platinum or palladium that is present in the said dewaxing catalyst in the range from 0.005% to 5% by weight, thereby obtaining a dewaxed oil (See page 6, lines 14-19; page 8, lines 27-28; page 9,

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lines 2-26; page 10, lines 3-26; page 11, lines 19-22; column 12, lines 2-4; page 22, lines 5-9);

(d) isolating by means of distillation two or more base oil grades from the dewaxed oil obtained in step (c) (See page 21, lines 14-15);

(e) isolating a dewaxed gas oil from the dewaxed oil obtained in step (c) (See figure 1 [stream 19] and page 13, lines 17-18, 24-25).

Gilbert invention does not specifically disclose use of MTW zeolite, however, the invention does disclose use of several intermediate pore zeolites, for example ZSM-5, ZSM-12, ZSM-22, ZSM-23, ZSM-32, ZSM-35 and ZSM-48 (See page 9, lines 11-23). It is to be noted that ZSM-12 has MTW-type topology (evidenced by Van Ballegoy et al: US Patent 6,576,120: column 4, lines 30-31).

Gilbert invention does not appear to specifically disclose the weight ratio of zeolite to the binder material, however, the invention does disclose that the catalyst is obtained by contacting an extrudate of zeolite and binder with an aqueous solution of fluorosilicate salt (See page 22, lines 7-9). Obviously, the amounts of binder and zeolite are result-effective variables to prepare a catalyst with proper formulation. Thus, one skilled in the art would optimize the weight ratio of zeolite to the binder material by routine experimentation. See *In re Boesch*, 617 F.2d 272, 205 USPQ 215 (CCPA 1980).

Gilbert does not specifically disclose the boiling range of gas oil fraction obtained in step (e), however, since a typical gas oil has a typical boiling range, it is expected that the gas oil fraction obtained in step (e) will inherently have similar boiling range as claimed.

Gilbert invention does not specifically disclose using a mineral crude derived feed, however, the invention does disclose that in addition to the FT product also other fractions may be additionally processed in step (a) (See page 4, lines 29-31).

Chen discloses a process for making base oil products using a hydrocarbon feed, operating conditions and catalyst similar to Gilbert (See abstract). Chen also discloses that feed can be of a high boiling point petroleum origin or a product from Fischer Tropsch (FT) synthesis (See column 6, lines 20-25). Obviously, feed stocks from petroleum origin and FT synthesis for the production of multiple grades of base oil products are equivalent (evidenced by Moore, Jr. US Patent 6,583,186: column 5, lines 65-67; column 6, lines 1-6 and also by Miller, US Patent 6,663,768: column 4, lines 65-67; column 5, lines 1-4).

Thus, it would have been obvious to one skilled in the art at the time of invention to modify Gilbert invention and use a mineral crude derived feed as disclosed by Chen, because feed stocks from both sources (FT and mineral crude derived) are expected to produce multiple grades of base oil products. An express suggestion to substitute one equivalent component or process for another is not necessary to render such substitution obvious. See *In re Fout*, 675 F.2d 297, 213 USPQ 532 (CCPA 1982).

7. With respect to claim 2, Gilbert discloses initial boiling point of the feed to step (a) should be above 340°C (See page 12, lines 23-25). Thus, it is expected that more than 20 wt% of the mineral feed to step (a) should boil in the claimed range.

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8. With respect to claim 3, Gilbert discloses that a fraction of the dewaxed oil is recycled to step (b) to be mixed with the effluent before distilling (See figure and page 13, lines 24-25).

9. With respect to claim 4, Gilbert discloses that a portion of full range residue obtained in step (b) is recycled to step (a) to be mixed with the feed before hydrocracking (See figure [stream 21] and page 13, lines 4-5).

10. With respect to claim 5, Gilbert discloses that hydroisomerization step of a FT product is especially directed to prepare a base oil precursor fraction having the desired properties (See page 1, lines 19-21). Gilbert also discloses that the isomerized product has a content of non-cyclic iso-paraffins of more than 80 wt% (See page 1, lines 8-9). Thus, it would have been obvious to one skilled in the art at the time of invention to modify Gilbert invention and add a hydroisomerized paraffin fraction to the feed for dewaxing.

11. With respect to claim 6, Gilbert discloses that the dewaxed oil of step (c) is subjected to an additional hydrofinishing step (See page 11, lines 7-12).

12. With respect to claim 7, Gilbert discloses that the hydrogen partial pressure in step (c) is 10-200 bar (See page 10, lines 27-30).

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13. With respect to claim 8, Gilbert discloses that the base oil grades obtained in step (d) each comprises more than 95 wt% saturates and have a viscosity index of 103 and 122 (See page 18, Table 1).

14. With respect to claims 9 and 10, Gilbert discloses that a dewaxed gas oil made by process of claim 1, with aromatics virtually absent, sulfur content of less than 5 ppmw (See page 3, lines 13-28) and pour point below -24°C (See page 4, line 6).

Double Patenting

15. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

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16. Claims 1-10 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-14 of copending Application No. 10/591,115. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claimed invention and the copending Application '115, both are drawn to a process of making multiple grades of base oil production by similar steps of hydrocracking, separation, catalytic dewaxing, hydrotreating/hydrofinishing and isolating into different fractions. The only difference is that the present invention claims a MTW zeolite and a Group VIII metal catalyst for dewaxing. It would have been obvious to one skilled in the art at the time of invention to modify the claim(s) of copending Application '115 and use a MTW zeolite because any intermediate pore zeolite, including MTW, can be used in the dewaxing step. Also, the present invention claims a gas oil product produced in the process, not claimed in the copending Application '115. It would have been obvious to one skilled in the art at the time of invention to modify the claim(s) of copending Application '115 and claim a gas oil product because the invention is producing gas oil also.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Response to Arguments

17. Applicant's arguments filed 12/04/2008 have been fully considered but they are not persuasive.

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18. In the arguments on page 4 (paragraph 3), the Applicant argues that the amendment to the independent claim renders the rejection moot.

The Applicant's argument is not persuasive because the amended claim 1 is obvious over Gilbert in view of Chen as presented above under claim 1.

19. On page 4 (paragraph 4) of the response, Applicant has not challenged the provisional obviousness-type double patenting rejection above and is deferring filing of a terminal disclaimer on indication of allowable subject matter.

Conclusion

20. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of

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the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PREM C. SINGH whose telephone number is (571)272-6381. The examiner can normally be reached on 7:00 AM to 3:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glenn Caldarola can be reached on 571-272-1444. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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/Glenn A Caldarola/
Acting SPE of Art Unit 1797

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